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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/200-312	09/15/81	J. MARCUS	DR 12 100 64

STANLEY A. MARCUS
P. O. BOX 11124
FEDERAL BLDG. 370
DETROIT, MI 48233

EXAMINER	
JOHN A.	
ART UNIT	PAPER NUMBER
10	9

DATE MAILED: 09/15/81

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined. Responsive to communication filed on Sept. 10, 1982 This action is made final.

A shortened statutory period for response to this action is set to expire _____ month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I: THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892 2. Notice of Informal Patent Drawing, PTO-948
3. Notice of References Cited by Applicant, PTO-1449 4. Notice of Informal Patent Application, Form PTO-152

Part II SUMMARY OF ACTION

5. _____

1. Claims 62 to 71 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims 68 to 71 are allowed.

4. Claims _____ are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. The formal drawings filed on _____ are acceptable.

8. The drawing correction request filed on _____ has been approved. disapproved.

9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has

been received. not been received. been filed in parent application, serial no. _____, filed on _____.

10. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

11. Other

Serial No. 254,313

-2-

Art Unit 143

12. The amendment after final rejection and accompanying 37 CFR 1.132 declaration have been entered and considered.

Claims 60 to 71, all the claims in this application, are allowed however this application is not being sent to issue at the present time.

In view of 37 CFR 1.202, action on this case is suspended for six months to determine whether an interference will be declared (unless these claims are canceled). At the end of the six months applicant should call up the case for action.

V.Hoke:jcm

703-557-3804

9/24/82

9/28/82

VP Hoke
VERNON P. HOKE
PRIMARY EXAMINER
ART. PAT. 143



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/273,669	11/18/88	CHENARD	

J MNTC006A

EXAMINER

HOKE, V

ART UNIT	PAPER NUMBER
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153

57

DATE MAILED:

06/29/90

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 4-5-90 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, Form PTO-152
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 71,73-75,77,78,80-85,87,89,91,92,94-102,104-106,108,111-119,121-123,125,126,128-134,136-138,140,141,143 to 233 are pending in the application.
108,109,111 to 149, 121-123, 125, 126, 128-134, 136-138, 140, 141 are withdrawn from consideration.
2. Claims _____ have been cancelled.
3. Claims 192-233 are allowed.
4. Claims 71,80-85,91-102,104-106,108,109,111-119,128-134,143-192 are rejected.
5. Claims 73,75,77,78,80-85,87,89,92,104-106,108,109,121-123,125,126,136-138,140,141 are objected to.
6. Claims _____ are subject to restriction or election requirement.
7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. Formal drawings are required in response to this Office action.
9. The corrected or substitute drawing have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).
11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).
12. Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.
13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. Other

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

Claims 71, 80-85, 90, 94-102, 111-119, 128-134, 143-191 are rejected under 35 U.S.C. 102(a) as being fully met by Japanese Kokai 56-2336 and 55-160,044 for the reasons of record.

Applicants absence of stipulating the possible Sn-halide bonding in claims such as 71 and 85 and absence of stipulating the possible Sn-S(R/Coor) R-OH/RCOOH bonding in claims such as 149-191 does not obviate the rejection since in the failure to recite the remaining Sn linked moieties (which can be ostensibly be halogen in the first instance and mercapto groups in the second), the organotin mercapto/acid/ester halides of these references dual stabilizer system (organotin plus mercapto alcohol-derived monocarboxylic acid ester) is not precluded by said incomplete organotin compound definitions. Contrary to applicants contention while the above set of claims may be considered narrower in one aspect (Sn-halide bonding as opposed to Sn-O, Sn-P or Sn-S bonding) the failure to recite the remaining moiety's scope, (teravalent organotin compounds are contemplated), indicates that the references remaining mercapto radicals' presence are not precluded. Therefore the claims are even broader than the claims

Art Unit 153

which they replace (59-62 and 64-69) since the ^{re} is no stipulation that the remaining radical be a residue resulting from the "removal of a hydrogen atom from the oxygen atom of a carboxylic acid, an alcohol or a polyol" or "removal of the hydrogen from the sulfur atom of a mercaptan, mercapto acid, mercapto alcohol, mercapto acid ester or mercapto alcohol ester". Since applicants organotin compound is now even broader the Board's holding that the Japanese references showed more of the claimed compound than the affidavit evidence presented is yet a valid basis for concluding that a generic concept was not established by applicants prior to these references publications.

16. Claims 71, 80-85, 90, 94-102, 111-119, 128-134 and 143-148 are rejected under 35 U.S.C. 102(b) as being Bresser et al (984).

The rejection remains since applicants Sn-linked mercapto acid ester residue definition does not preclude references S,S' linked mono or dicarboxylic acid ester linked Sn compounds.

17. Claims 149, 156, 163-166, 172, 173-176, 183, 184 and 191 are rejected under 35 U.S.C. 102(e) as being fully met by Kugele (114).

Contrary to applicants counsels assertion these claims broad mercapto alkenol ester of a mono carboxylic acid do not define over those of this reference wherein the acid is a mercapto substituted acid. Monocarboxylic acid is generic thereto. Hydrocarbyl mono-carboxylic would obviate the rejection.

Art Unit 153

18. Claims 73, 74, 75, 77, 78, 87, 88, 89, 91-92, 104-106, 108, 109, 121-123, 125, 126, 136-138, 140, 141 and 192-227 are allowed.

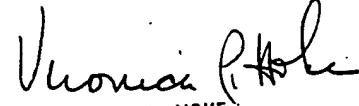
19. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE (3) MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO (2) MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE (3) MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX (6) MONTHS FROM THE DATE OF THIS FINAL ACTION.

V. HOKE:asj

6/24/90

6/29/90



VERONICA P. HOKE
PATENT EXAMINER
GROUP 150 - ART UNIT 153



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/633,187	12/28/90	CHENARD	J MNTC-0006-B

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER
1300 I STREET, N. W.
WASHINGTON, DC 20005-3315

EXAMINER

HOKE, V

ART UNIT

PAPER NUMBER

1509

1164

DATE MAILED:

10/18/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

Dec. 28, 1990

This application has been examined Responsive to communication filed on April 17, 1991 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892.	2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.
3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.	4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152
5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.	6. <input type="checkbox"/> _____

Part II SUMMARY OF ACTION

73-75, 77, 78, 80-84, 87-89, 91, 92-106, 108, 109, 114-118, 121-123, 125, 126,
1. Claims 128-134, 136-141, 143-151, 153-158, 200-207, 209 are pending in the application.
to 217, 219-225, 227-246.
Of the above, claims _____ are withdrawn from consideration.

2. Claims 193-198, 200-207, 209-217, 219-225, 227-233, 237 to 246 have been cancelled.

3. Claims 73-75, 77, 78, 80-84, 87-89, 91-106, 108, 109, 111-118, 121-123, 125, 126, 128-134, 136- are allowed.

4. Claims 141, 143-151 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. 070,503; filed on 8-28-97 *grand grand*

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

15.

The preliminary amendments dated December 28, 1990 and April 17, 1991 have been entered.

16.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 80-84, 94-102, 14-118, 128-134 and 143-191 are rejected under 35 U.S.C. § 102(a) as being fully met by each of Japanese Kokai 56-2336 ad Japanese Kokai 55-160,044.

The examiner's rationale as will be explained hereinbelow, is the same as set forth in paragraph 15 of the Office action dated June 26, 1990 in the parent application SN 273,669, filed November 18, 1988, now abandoned. The traversal made in anticipation of this rejection (preliminary amendment dated April 17, 1991 pages 6 thorough 14) is clearly untenable. The claims here are even more broad than those set forth in the grandparent application 254,313 in which the Board of Patent Appeals and Interferences held that the subject matter claimed was unsupported in any of those applications as well as their French

priority application dated filed. Applicants exhibit "B" at page 4 relates the pertinent portion of said decision as follows:

"The present application, Serial No. 254,313, enlarges the scope of both the mono- or diorganotin derivative and the mercapto ester used to stabilize the polyvinyl halide polymer. In particular, the tin derivative now claimed includes a mono- and diorgano- tetravalent tin derivative where the remaining valences are satisfied by halogen and phosphorus as well as by the removal of the hydrogen atom from the oxygen atom of a carboxylic acid, an alcohol or toluol and the removal of hydrogen atom from the sulfur atom of the mercaptan, mercapto alcohol, mercapto acid or mercapto alcohol ester (see pp. 14-16). And the mercapto ester now includes the addition of optional substituents, as well as the addition of oxygen, carbonyl oxy, nitrogen and sulfur in the linear hydrocarbylene chain. Also, in forming the mercapto ester by reacting an acid with a mercapto alcohol, acid-capped polyethers, acid-capped silicone esters, and amino acids are now disclosed as useful (see pp. 8-13).

From our review of the parent application and the present application, we agree with the examiner that appellants are not entitled to the benefit of the filing date of their parent application for the instant claims on appeal since they define subject matter not disclosed in the parent case. Since appellants cannot claim benefit of the filing date of their parent case, claims 59 through 62 and 64 through 69 are accorded the date of April 15, 1981, the filing date of the instant application, and the Japanese documents and the Kugele patent are available 35 USC 102 references. We are not persuaded by appellants' argument that their French application and parent application disclosures are sufficient to show that appellants were in possession of a generic concept. The term "invention" as used in 35 USC 120 refers to the claimed invention and not a concept." (Emphasis added)

Since applicants were held to not be in possession of a generic concept of a claim having a organotin-sulfur bonded stabilizer and having certain additional tin-ligands specified, e.g. Sn-Cl, it is specious to contend that the instant claims' organotin-sulfur bonded compounds having no additional tin-ligand bonding(s) stated, the tin here being equally tetravalent by

virtue of the possible diorgano and sulfur stipulations, presents subject matter that applicants earlier US filed applications and French priority application provide an enabling support therefore either.

Office Action Dated October 29, 1989 in SN 273,669

As stated in the examiner's answer in the parent application 254,313 filed April 15, 1981 and appealed to the PTO Board of Patent Appeals and Interferences (paper no. 35 page 5) "Applicants do not specifically disclose the mono and di-organo tin mercapto acid ester halide of these references. Their claims stipulation however, that the organotin stabilizer can contain a Sn-halide link as well as the Sn-S link derived from reacting an organotin compound with a mercaptan or mercapto acid/ester indicates that such broad language encompasses references' tin stabilizers which are similarly used with mercapto esters.

It is considered that applicants having now presented for the first time in their series of foreign and US applications, specific referral to such organotin mercapto acid ester halides in the instant application which was filed subsequent to the reverence disclosures' publication, rejection as fully anticipated inventions under 35 USC 102 (a) is justified.

The assertion that the 37 CFR 1.131 declaration filed August 13, 1984 established that applicants were in possession of a generic concept encompassing the use of all known organotin

stabilizers prior to the references' publications, is contradicted by the fact that applicant had contended during the grand parent application's prosecution that their organotin component's recitation, which was then couched in the even broader terminology "a metal containing stabilizer", was distinct from Gough's organotin borate. See attached exhibit A, page 2, third paragraph. This traversal was clearly untenable and is so even in this application inasmuch as the organotin stabilizer is specially stated as possibly containing a Sn-O link, and no prohibition that the oxygen be further linked to boron is indicated in either the claims or the disclosure.

Having expressly abandoned the parent application for the purpose of filing this application in order to provide support for the broad tin stabilizer terminology and also ostensibly for purpose of avoiding Gough's organotin borate, Appellants are in no position to assert that they were in possession of a generic concept in using any and all organotin compounds prior to the references' publications, independent of what other species their declarations espoused as having been earlier reduced to practice."

Applicants contended that their earlier foreign applications and parent application relate that they were possession of a generic invention in the organotin-mercapto ester stabilizer concept and that therefore the presence as an added stabilizer of

Office Action Dated June 29, 1990 in SN 273,669

Applicants absence of stipulating the possible Sn-halide bonding and absence of stipulating the possible Sn-S(R/COOR) R-OH/RCOOH bonding in the claims does not obviate the rejection since in the failure to recite the remaining Sn linked moieties (which can be ostensibly be halogen in the first instance and mercapto groups in the second), the organotin mercapto/acid/ester halides of these references dual stabilizer system (organotin plus mercapto alcohol-derived monocarboxylic acid ester) is not precluded by said incomplete organotin compound definitions. Contrary to applicants contention while the above set of claims may be considered narrower in one aspect (Sn-halide bonding as opposed to Sn-O, Sn-P or Sn-S bonding) the failure to recite the remaining moiety's scope, (tetravalent organotin compounds are contemplated), indicates that the references' remaining mercapto radical's presence are not precluded. Therefore the claims are even broader than the claims which they replace (59-62 and 64-69) since there is no stipulation that the remaining radical be a residue resulting from the "removal of a hydrogen atom from the oxygen atom of a carboxylic acid, an alcohol or a polyol" or "removal of the hydrogen from the sulfur atom of a meraptan, mercapto alcohol, mercapto acid ester or mercapto alcohol ester". Since applicant's organotin compound is now even broader, the Board's holding that the Japanese references showed more of the

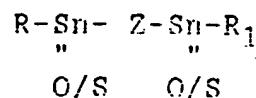
claimed compound than the affidavit evidence presented is yet a valid basis for concluding that a generic concept was not established by applicants prior to these references publications.

17.

Claims 73-75, 77, 78, 80-81, 87-89, 91, 92-106, 108, 109, 114-118, 121-1232, 125, 126, 128-134, 136-141, 143-191, and 234 to 236 are rejected under 35 U.S.C. § 102(b) as being fully met by Bresser et al (984).

Office Action Dated October 5, 1989 in SN 273,669

This US patent claims the use of a mercapto alkanol derived monocarboxylate and a bis (organotin) compound having the formula



where R and R₁ are each essentially hydrocarbyl and Z is a S,S' linked mono or di carboxylic acid ester radical.

Applicants foreign priority and earlier filed US applications are not seen to provide support for these S,S' carboxylic acid ester linked bis organotin compounds. Applicants species as well as generic formulas (page 15 and 16) do not encompass such compounds since all the compounds on page 16 are only -S- linking - tin - containing while those that do have a S,S' linking carboxylic acid ester group (page 15, line 16) do not contain any Sn = O/S bonding since R⁴ is always hydrocarbyl.

Office Action Dated June 29, 1990 in SN 273,669

The rejection remains since applicants Sn-linked mercapto acid ester residue definition does not preclude references S,S' linked mono or dicarboxylic acid ester linked Sn compounds. 18.

Claims 73-75, 77, 78, 80-84, 87-89, 91, 92-106, 108, 109, 114-118, 121-123, 125, 126, 128-134, 136-141, 143-191, 234 and 236 are rejected under 35 U.S.C. § 102(a) as being fully met by Kugele et al (114).

Office Action Dated in SN 273,669

Applicants claims are broad enough to encompass the organotin halide and mercapto alkanol derived mercapto acid ester stabilizer system of this references (claim in col. 29 - component "B") for which aspect support is found in this application on page 8 vis - a - vis the G radical is - C⁰ - R³-SH and pages 14-16 for the organotin halide. See col. 15 of the Kugele patent.

Inasmuch as this invention is claimed by Kugele et al it can be obviated only by determining the first inventor through an interference proceeding. Applicant should copy any claim(s) which they believe can be make in order to initiate such proceeding.

Office Action Dated in SN 273,669

Contrary to applicants counsels assertion these claims broad mercapto alkanol ester of a mono carboxylic acid do not define over those of this reference wherein the acid is a mercapto substituted acid. Monocarboxylic acid is generic thereto. Hydrocarbyl mono-carboxylic would obviate the rejection.

19.

This is a continuation of applicant's earlier application S.N. 273,669. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action in this case. See M.P.E.P. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Hoke:ab
October 16, 1991

703 - 308-2351

Veronica P. Hoke
VERONICA P. HOKE
PRIMARY EXAMINER
ART UNIT 159B